

REMARKS

Applicant has thoroughly considered the Examiner's remarks in the May 18, 2007 Office action and have amended the application to more clearly set forth aspects of the invention. This Amendment A amends claims 1, 15, 29, 36, 42, 48 and 60-62 and cancels claims 10, 33, 39, 45 and 51.

Claims 1-9, 11-32, 34-38, 40-44, 46-50 and 52-62 are thus presented in the application for further examination. Reconsideration of the application as amended and in view of the following remarks is respectfully requested.

Claim Objections

Claims 60-62 stand objected to because they recite "A computer readable medium ..., said medium including instructions for." The claims have been amended per the Examiner's suggestion and the objection should be withdrawn.

Claim Rejections Under 35 U.S.C. § 101

Claims 1-41 stand rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Claim 1, as amended, recites "A system for handling an electronic communication, said system including **a computer executing instructions to perform a method of...**". Thus, Applicant asserts that claim 1 does not lack the necessary structure elements (a computer) to be a "system" and is directed to statutory subject matter. To the extent that independent claims 15, 29 and 36 have been similarly, these claims should be allowed for at least the same reasons as claim 1 should be allowed. Claims 2-9, 11-14, 16-28, 30-32, 34, 35, 37, 38, 40 and 41 depend from claims 1, 15, 29 and 36, respectively, and should be allowed for at least the same reasons as claims 1, 15, 28 and 36 should be allowed.

Claim Rejections Under 35 U.S.C. § 102

Claims 1-9 and 13 stand rejected under 35 U.S.C. 102(b) as being anticipated by Mastrianni (U.S. Pub. App. 2002/0116641), hereinafter "Mastrianni". A claim is anticipated only if each and every element as set forth in the claim is disclosed, either expressly or inherently

in a single prior art reference.¹ Applicant respectfully submits that each and every element as set forth in the recited claims is not found, either expressly or inherently in the Mastrianni reference. Thus, Mastrianni does not anticipate the claims.

The Mastrianni reference teaches client side email filtering based on message semantics. (Mastrianni, Abstract). Specifically, Mastrianni teaches filtering messages based objectionable phrases or words found by scanning URLs in the message. (Mastrianni, page 3, paragraph 37). A semantic engine determines whether the email, not the URL, is objectionable. (Mastrianni, page 3, paragraph 42).

In contrast, claim 1 as amended recites "categorizing the identified URLs by **looking up the category of each identified URL via a categorizing server system.**" The recitals are supported in the specification of the present application at, for example, page 12, paragraph 42. For example, the URL parser parses the electronic communication for URLs and the URLs are categorized by an online toolkit via a server accessing a URL database. (Specification, page 12, paragraph 42; FIG. 2). The electronic communication is rated by policy based on the categories of the URLs. (Specification, page 12, paragraph 42; FIG. 2).

Applicant respectfully submits that each and every element such as "**categorizing the identified URLs by looking up the category of each identified URL via a categorizing server system**" is not found, either expressly or inherently, in the Mastrianni reference. Thus, Mastrianni does not anticipate the claim 1. Furthermore, claims 2-9 and 13 depend from claim 1 and should be allowed for at least the same reasons as claim 1.

Claim Rejection Under 35 U.S.C. § 103

Claims 10-12 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mastrianni in view of in view of Goodman et al. (U.S. Pub. App. 2005/0022008), hereinafter "Goodman". Applicant respectfully disagrees. However, Applicant notes that, in this instance, Goodman cannot be the basis for a § 103(a) rejection and the rejection should be removed.

Goodman does not qualify as prior art under either of §§102(a) or 102(b) because the Goodman publication date of January 27, 2005 is after the effective filing date of the instant application filing date of August 25, 2003. Accordingly, Goodman can only be relied on as prior

¹ M.P.E.P. § 2131. See also *Schering Corp. v. Geneva Pharmaceuticals*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (citing *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

art for this §103(a) rejection if it qualifies as prior art under §102(c). Applicant wishes to invoke the §103(c) exception to establish that the reference may not be used as §103 prior art against the present application.²

Applicant would like to establish common ownership at this time: Application No. 10/647,824 to Packer and U.S. Pub. App. 2005/0022008 to Goodman et al. were, at the time the invention of Application No. 10/647,824 was made, owned by Microsoft Corporation, Redmond, WA (US). Accordingly, Goodman may not be used as §103 prior art against the present application. Applicant thus believes that claims 10-12 and 14 are patentable, and requests withdrawal of the rejection.

Claims 15-28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mastrianni, in view of Goodman, and further in view of Kester et al. (U.S. Pat. No. 7,194,464), hereinafter "Kester". Applicants respectfully disagree. However, for the reasons stated above, Goodman does not qualify as prior art. Accordingly, Goodman may not be used as §103 prior art against the present application. Applicant believes that claims 15-28 are patentable, and requests withdrawal of the rejection

With respect to the remaining claims, claims 29-62 stand rejected under the same rationale as claims 1-28. To the extent that independent claims 29, 36, 42, 48, 60 and 62 have been amended to include subject matter similar to claim 1, Applicant submits that these claims should be allowed for at least the same reasons as claim 1 should be allowed. Claims 30-32, 34, 35, 37, 38, 40, 41, 43, 44, 46, 47, 49, 50, 52 and 53 depend from and further limit claims 29, 36, 42 and 48 respectively, and should be allowed for at least the same reasons as claims 29, 36, 42 and 48.

To the extent that independent claims 54 and 61 include subject matter similar to claim 15, Applicant believes that claims 54 and 61 should be allowed for at least the same reasons as

² Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." MPEP 706.02(l)(1), first paragraph. In order to be disqualified as prior art under 35 U.S.C. 103(c), the subject matter which would otherwise be prior art to the claimed invention and the claimed invention must be commonly owned at the time the claimed invention was made. MPEP 706.02(l)(2), first paragraph.

claim 15 should be allowed. Claims 55-59 depend from and further limit claim 15, and should be allowed for at least the same reasons as claim 15.

Applicant submits that the claims are allowable for at least the reasons set forth herein. Applicant thus respectfully submit that claims 1-9, 11-32, 34-38, 40-44, 46-50 and 52-62 as presented are in condition for allowance and respectfully request favorable reconsideration of this application.

Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited aspects of the invention. The fact that Applicant may not have specifically traversed any particular assertion by the Office should not be construed as indicating Applicant's agreement therewith.

Applicant wishes to expedite prosecution of this application. If the Examiner deems the application to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the application in condition for allowance.

The Commissioner is hereby authorized to charge any deficiency or overpayment of any required fee during the entire pendency of this application to Deposit Account No. 19-1345.

Respectfully submitted,

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